

REMARKS

I. Introduction

This paper is filed in response to the final Office Action mailed March 18, 2008. A Request for Continued Examination and a two-month extension of time are filed concurrently herewith.

In the amendments, claims 1, 4, 6, and 27 are amended and claims 105 – 107 are added. No new matter is added by these amendments. After entry of the present amendments, claims 1-31 and 103 – 107 are pending.

The Applicants traverse each of the Office Action's rejections. Reconsideration and allowance of all pending claims is respectfully requested in view of the remarks below.

II. Rejection of Claims 1 – 11, 16 – 21, 23 – 24, and 26 – 31

The Office Action rejected claims 1 – 11, 16 – 21, 23 – 24, and 26 – 31 under 35 U.S.C. § 103(a) as allegedly being obvious in view of U.S. Patent No. 6,405,175 to Ng, U.S. Patent No. 7,092,821 to Mizrahi *et al.*, and U.S. Patent No. 7,181,518 to Matsumoto, *et al.* For the reasons set forth below, the Applicants respectfully traverse this rejection and requests its reconsideration and withdrawal.

Specifically, the Applicants submit that the Office Action failed to establish *prima facie* obviousness. To establish *prima facie* obviousness of a claimed invention under 35 U.S.C. § 103, the Office Action must show, either from the references themselves or in the knowledge generally available to one of ordinary skill in the art, that the cited references

disclose or suggest each claimed element and that it would have been obvious under *Graham v. John Deere Co.*¹ to modify the references or to combine teachings in the references to arrive at the claimed invention.² Such a showing requires Examiners to determine whether there was an apparent reason to combine elements in references and to articulate that reason.³ Applicants submit that (A) no reason or rationale exists for one skilled in the art to combine the disclosures in Ng, Mizrahi, and Matsumoto; (B) the Office Action failed to articulate the required findings to establish *prima facie* obviousness; and (C) even assuming they could be combined, the combination of cited references fails to disclose or suggest each claimed element.

A. No Reason to Combine Ng, Mizrahi, and Matsumoto

The Office Action combined a shopping website that rewards users that provide information about products (Ng) with a website providing for large scale group question and answer interaction (Mizrahi) and a system providing for Internet Relay Chat (IRC) (Matsumoto) to reject Applicants' claimed invention that is directed to exchanging information associated with small businesses. Yet, there is no reason to combine such systems together without using hindsight bias, which is impermissible.⁴ As stated in the Amendment and Response to Final Office Action, filed November 1, 2007, one of ordinary

¹ 383 U.S. 1 (1966)

² See MPEP §§ 2141 and 2143; *KSR Int'l Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d at 1395-96.

³ See *KSR Int'l Co. v. Teleflex, Inc.* 82 U.S.P.Q.2d at 1596 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

⁴ See MPEP § 2141(I).

skill in the art has no reason to combine elements in the cited references because, among others, the following:

1. Combining elements disclosed in Mizrahi with those disclosed in Ng changes the function of those elements, thereby teaching away from their combination.⁵
2. Both Mizrahi and Ng, and thus their combination, teach away from the claimed invention.⁶
3. Combining elements disclosed in Matsumoto with those disclosed in Ng changes the function of those elements, thereby teaching away from their combination.⁷

Ng, Mizrahi, and Matsumoto still teach away from their combination. For example, combining elements disclosed in Mizrahi and Matsumoto with those disclosed in Ng changes the function of combined elements. Ng discloses rewarding users that provide information about a product to a website.⁸ The rewards can include bonus online time, special offers, telephone calling card minutes, hotel nights, or other discounts.⁹ Ng determines the amount of reward points a user earns based on the provided information, the volume of users who actually use the provided information, and if the information provided is correct.¹⁰ The

⁵ See 11/1/2007 Amendment and Response, pp. 22 – 25.

⁶ See *id.* at p. 25.

⁷ See *id.* at pp. 26 – 27.

⁸ See Col. 4, lines 50 – 58.

⁹ See, e.g., Col. 9, lines 25 – 29.

¹⁰ See, e.g., Col. 5, lines 4 – 25.

Office Action proposed a combination using hindsight bias that renders the function of rewards in Ng worthless.

The Office Action proposed a modification to Ng to “include the step of determining access to the database based on the score [as allegedly disclosed by Mizrahi] to control and limit the exposure of information to a minimum number of participants so that it can be given meaningful rank, which rank is used as a basis for deciding if and how to disseminate the information.”¹¹ The Office Action contended Mizrahi disclosed such elements based on its discussion of a “trouble maker.”¹² The Office Action, again, confused Mizrahi’s disclosure of limiting the ability of a “trouble maker” to contribute to the system with limiting the “trouble maker’s” ability to receive information from the system in Mizrahi.¹³ Mizrahi does not disclose or suggest limiting a trouble maker’s ability to receive information from the system.¹⁴ Accordingly, there is no reason to modify Ng with teachings of Mizrahi since Mizrahi fails to disclose or suggest the modification proposed by the Office Action.

Moreover, Mizrahi discloses controlling exposure of information during an interactive event to a rate that is smaller than the maximum rate of assimilation and the information is disseminated to a minimum number of participants to receive a meaningful rank that can be used as a basis for deciding if and how to disseminate the information.¹⁵ Ng explicitly

¹¹ Office Action, p. 4.

¹² *Id.*; Mizrahi, col. 52, lines 5 – 63.

¹³ *See id.*

¹⁴ Mizrahi, Col. 52, lines 5 – 63.

¹⁵ Col. 2, lines 24 – 50.

teaches away from the modification proposed by the Office Action using Mizrahi's disclosure.

Modifying Ng with Mizrahi to change Ng's reward system (outputting rewards based on information provided by users) to an information system that outputs information to users based on information provided by them destroys the reward incentive in Ng for users to provide information and to correct and view information provided by other users. For example, no user would access information to correct it because they have no incentive to do so without rewards. Rewarding users that correct information is a basis by which Ng uses "consumers to build and maintain the information in the database at a minimum of cost."¹⁶ Thus, such a combination would destroy the reward incentive of which Ng is explicitly directed.

Moreover, there is no reason, and the Office Action failed to provide a reason, why one would modify Ng to base the output users receive (i.e. rewards) on the assimilation rate of the user as disclosed by Mizrahi. Such a combination is nonsensical and destroys the reward incentive in Ng for users to provide information. The reward system in Ng promotes user activity – whether providing information, correcting information, or having information they provided accessed – using rewards. Limiting rewards limits activity. Limiting rewards based on a user's ability to assimilate rewards is contrary to the reward incentive in Ng – which is to promote user activity to build and maintain a database of information.

¹⁶ Ng, Col. 3, lines 11 – 15.

The Office Action also contended that the combination of Ng and Mizrahi suggests determining access to receive a type and number of stored data elements.¹⁷ The combination of Ng and Mizrahi makes no such suggestion. Access to information is not controlled in Ng. Furthermore, Mizrahi controls a user's ability to input information based on a score indicating a "troublemaker" and not controlling output. Thus, neither reference, nor their combination, discloses or suggests limiting access to information based on a score. Accordingly, the Office Action failed to establish *prima facie* obviousness at least because there is no reason to combine Ng with Mizrahi or modify them as proposed by the Office Action using hindsight bias, and the Office Action failed to provide a sufficient reason.

The Office Action further modified the combination of Ng and Mizrahi with Matsumoto, stating that it would have been obvious to combine Matsumoto's alleged teaching of limiting access to a type and number of stored data elements based on a score "in order to limit the effects of or prevent fraudulent product reviews."¹⁸ Even assuming Matsumoto discloses the elements as alleged by the Office Action,¹⁹ there is no reason to combine the cited references since Ng and Mizrahi teach away from the modification with elements from Matsumoto as proposed by the Office Action. Combining the teachings of Matsumoto with Ng and Mizrahi would destroy the rewards in Ng that provide an incentive for users to correct product information that is incorrectly entered by other users. If users that provided incorrect product information are blocked from receiving information from the

¹⁷ Office Action, p. 4.

¹⁸ Office Action, pg. 5.

system, there is no incorrect information to correct for other users to receive rewards as explicitly contemplated by Ng. Moreover, Ng discloses providing access to rewards based on input provided by users (such as product information and correcting product information). Combining Ng and Mizrahi with Matsumoto would create a system in which a user receives rewards, even without providing information, unless they submit fraudulent product reviews. Thus, there is no reason to combine Ng, Mizrahi, and Matsumoto and the Office Action failed to provide a sufficient reason.

For at least these reasons, the Applicants submit the Office Action failed to establish *prima facie* obviousness. Withdrawal of the rejection and allowance of claims 1 – 11, 16 – 21, 23 – 24, and 26 – 31 is kindly requested.

B. *Failure to Articulate the Required Findings for Prima Facie Obviousness*

Furthermore, the Office Action failed to articulate the required findings to establish *prima facie* obviousness for claims 1 – 11, 16 – 21, 23 – 24, and 26 – 31. The Office Action's alleged reason why one of ordinary skill in the art would combine Ng, Mizrahi, and Matsumoto appears to be "some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention."²⁰ The Office Action's mere conclusory statements that there is some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or combine prior

¹⁹ As explained below, Matsumoto fails to disclose or suggest limiting access to a type and number of stored data elements based on a score.

²⁰ See Office Action, pp. 3 – 5.

art reference teachings are impermissible.²¹ The *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex*, Federal Register, Vol. 72, No. 195, p. 57527, 34 (October 10, 2007) identify the findings Office personnel must articulate to reject claims on the basis of some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or combine prior art reference teachings.²² The findings include the following:

- (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- (2) a finding that there was a reasonable expectation of success; and
- (3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration.²³

The Office Action failed to articulate findings for at least (1) and (2) above or merely offered conclusory statements for these and other required findings. Accordingly, the Applicants submit that the Office Action failed to establish *prima facie* obviousness and

²¹ *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”); underlining supplied.

²² Also see MPEP § 2141 *et seq.*

²³ *Examination Guidelines for Determining Obviousness*, Federal Register, Vol. 72, No. 195, at p. 57534.

requests withdrawal of the rejection. Should the Office still opine, after reviewing the present response and the *Examination Guidelines for Determining Obviousness*, that one or more of the pending claims are obvious, a full and clear statement of the grounds on which these claims are rejected pursuant to MPEP § 707.07(d) is requested so that any rejection is clearly articulated to provide the Applicants with the opportunity to provide evidence of patentability or otherwise reply completely at the earliest opportunity.²⁴

C. *The Cited References Fail to Disclose or Suggest Each Claimed Element*

As stated above, to establish *prima facie* obviousness of a claimed invention under 35 U.S.C. § 103, the Office Action must show, among other things, that the cited references disclose or suggest each claimed element.²⁵ The combination of Ng, Mizrahi, and Matsumoto, even if combinable, fail to disclose or suggest each claimed element. For at least that reason, Applicants kindly request withdrawal of the rejection.

- i. Determining the contributing member's access to the exchange repository to receive a type and number of stored data elements in the exchange repository based, at least in part, on the score.

As an example, Ng, Mizrahi, and Matsumoto, individually or in combination, fail to disclose or suggest “determining the contributing member’s access to the exchange repository to receive a type and number of stored data elements in the exchange repository based, at least in part, on the score,” as recited in claim 1. Claim 27 recites a similar element. The Office Action acknowledged that neither Ng nor Mizrahi discloses limiting a member’s

²⁴ See 35 U.S.C. § 132; MPEP § 706.

²⁵ See MPEP §§ 2141 and 2143; *KSR Int’l Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d at 1395-96.

access to receive a type and number of stored data elements.²⁶ As shown above in Section (II)(A) of the present response, Ng and Mizrahi both fail to suggest limiting a member's access to receive a type and number of stored data elements. The Office Action contended Matsumoto "clearly discloses limiting access to a type and number of stored data elements based on a score."²⁷ However, Matsumoto neither discloses nor suggests limiting access to a type and number of stored data elements based on a score.

Matsumoto relates to an Internet Relay Chat (IRC) system that, as cited by the Office Action, allows IRC clients to exchange text messages using a channel.²⁸ Users are rated if they send URLs against public moral and decency and can be prevented from joining a channel based on their rating.²⁹ Being prevented from joining a channel is not limiting access to a type and number of stored data elements. It is limiting access to a channel – which is not a type and number of data elements – to exchange text messages – which are not stored data elements. Since Matsumoto fails to disclose or suggest the element that the Office Action contended the combination of Ng and Mizrahi fails to disclose, claims 1 – 11, 16 – 21, 23 – 24, and 26 – 31 are patentable in view of the cited references. Withdrawal of the rejection and allowance of claims 1 – 11, 16 – 21, 23 – 24, and 26 – 31 is kindly requested.

²⁶ Office Action, p. 5.

²⁷ *Id.*

²⁸ Col. 1, lines 18 – 26.

²⁹ Col. 7, line 60 – col. 8, line 37; col. 12, line 58 – col. 13, line 2; col. 13, lines 15 – 25.

ii. Information related to a small business entity and at least one individual associated with the small business entity.

The cited references fail to disclose or suggest other claim elements. For example, Ng, Mizrahi, and Matsumoto, individually or in combination, fail to disclose or suggest, “the plurality of contributed data elements comprising information related to a small business entity and at least one individual associated with the small business entity,” “creating a member profile for the contributing member, said member profile comprising a statistics file, which includes at least statistics regarding a type and number of the plurality of contributed data elements,” and “determining a score for the statistics file by comparing the statistics to a threshold,” as recited in amended claim 1. Amended claim 27 recites similar elements. None of the cited references disclose or suggest information related to a small business entity and at least one individual associated with the small business entity. Thus, none of the cited references disclose or suggest statistics on contributed data elements comprising information related to a small business entity and an associated individual, or determining a score for such statistics.

Ng relates a website in which users provide information about products that are not small business entities or individuals associated with small business entities. Mizrahi relates to supporting large group interactions online in which the information exchanged is not disclosed or suggested as relating to small business entities or individuals associated with small business entities. Matsumoto relates to IRC technology in which users access a channel to exchange text messages that are not disclosed or suggested as relating to small business entities or individuals associated with small business entities.

Since Ng, Mizrahi, and Matsumoto, individually or in combination, fail to disclose or suggest each claimed element, the cited references fail to render claims 1 – 11, 16 – 21, 23 – 24, and 26 – 31 obvious and the Office failed to establish *prima facie* obviousness. Withdrawal of the rejection and allowance of claims 1 – 11, 16 – 21, 23 – 24, and 26 – 31 is kindly requested.

iii. Dependent claims.

Dependent claims 2 – 11, 16 – 21, 23 – 24, 26, and 28 – 31 are patentable for other reasons. The Office Action's basis for rejecting certain dependent claims is inconsistent with the elements recited by such claims. For example, the Office Action rejected claims 6 and 29 stating, "Ng discloses awarding prizes to users ... and [v]erifying user account information is old and well known." Neither claim 6 nor claim 29 relate to anything that the Office Action contended that Ng discloses or is "old and well known." As an example, claim 6 recites, "wherein determining the score for the statistics file by comparing the statistics to the threshold comprises comparing the statistical file to the member profile to determine consistency of the type and number of contributed data elements," which does not relate to awarding prizes to users or verifying user account information.

In rejecting claims 8 – 10, the Office Action stated "Ng discloses creating a user account and a user receiving prizes ... [and] mailing a prize to a user's home address is old and well known." None of claims 8 – 10 relate, even remotely, to creating a user account for a user receiving prizes or mailing a prize to a user's home address. Examination and allowance of claims 6, 8 – 10, and 29 is kindly requested.

The Office Action rejected claim 25 by stating “making a change to a database as a result of a legal action is old and well known.” As an initial matter, the Applicants request that the Office provide evidence, pursuant to MPEP § 707.07(d) for subject matter the Office contends is “old and well known” so that any rejection is clearly articulated to provide the Applicants with the opportunity to provide evidence of patentability or otherwise reply completely at the earliest opportunity.³⁰ Moreover, the Office Action failed to articulate an apparent reason why one of ordinary skill would modify the combination of Ng, Mizrahi, and Matsumoto, as is required.³¹ Finally, claim 25 does not recite making a change to a database as a result of legal action. Claim 25 recites, “modifying information relating to a business entity in view of a result from a disclosure and dispute procedure.” Examination and allowance of claim 25 is kindly requested.

III. Rejection of Claims 12 – 15 and 22

The Office Action rejected claims 12 – 15 and 22 under 35 U.S.C. § 103(a) as allegedly being obvious in view of Ng, Mizrahi, Matsumoto, and U.S. Patent No. 5,710,884 to Dedrick. Claims 12 – 15 and 22 are ultimately dependent upon claim 1 for which reasons for allowance are provided above. For at least those same reasons, the Applicants submit claims 12 – 15 and 22 are patentable in view of the cited references.

Claims 12 – 15 and 22 are patentable for other reasons. For example, the Office Action failed to establish *prima facie* obviousness. The Office failed to show the cited

³⁰ See 35 U.S.C. § 132.

references disclose or suggest any element recited in claims 12 – 15 and 22. Moreover, the Office Action failed to articulate the required findings for combining references to reject claims under Section 103.³²

Allowance of claims 12 – 15 and 22 is kindly requested.

IV. New Claims 105 – 107

New claims 105 – 107 depend from and further limit claim 1. Reasons for allowance of claim 1 are provided above. For at least those same reasons, the Applicants submit claims 105 – 107 are patentable in view of the cited references. Examination and allowance of claims 105 – 107 is kindly requested.

³¹ See *KSR Int'l Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d at 1395-96.

³² See MPEP § 2141 *et seq.*

CONCLUSION

Claims 1-31 and 103 – 107 are pending in the application. The Office Action rejections are believed to be traversed by the present amendment and response. Allowance of claims 1-31 and 103 – 107 is respectfully requested. The Examiner is invited and encouraged to contact the undersigned attorney of record at (404) 745-2520 if such contact will facilitate a Notice of Allowance for claims 1-31 and 103 – 107. The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 11-0855.

Respectfully submitted,

/Jason D. Gardner 58180/

Jason D. Gardner

Reg. No. 58,180

Attorney for the Applicants

DATE: August 15, 2008
KILPATRICK STOCKTON LLP
1100 Peachtree Street
Suite 2800
Atlanta, Georgia, 30309-4530
404 745-2520 (direct)
404 541 4619 (direct fax)